Modified PTO/SB/33 (10-05)

PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number Q64919	
Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	Application Number 09/880,045	Filed June 14, 2001
	First Named Inventor Kyoko KIMPARA	
	Art Unit 3639	Examiner Igor N. BORISSOV

WASHINGTON OFFICE
23373
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Applicants request review of the final rejection in the above-identified application. A notice of appeal, a supplementary amendment and a petition for extension of time is being filed with this request.

The review is requested for the reasons(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

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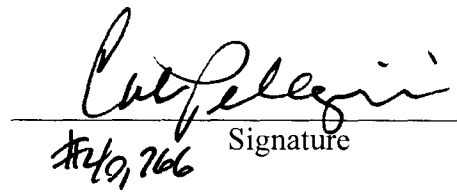
Signature

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September 28, 2006
Date

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Kyoko KIMPARA, et al.

Docket No: Q64919

Appln. No.: 09/880,045

Group Art Unit: 3639

Confirmation No.: 5944

Examiner: Igor N. BORISSOV

Filed: June 14, 2001

For: CONTENTS CONVERSION FEE CHARGING SYSTEM, CONTENTS CONVERSION FEE CHARGING METHOD AND STORAGE MEDIUM STORING PROGRAM FOR CONTROLLING SAME

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the final Office Action dated April 28, 2006, and the Advisory Action dated August 21, 2006, Applicants file this Pre-Appeal Brief Request for Review. Applicants are concurrently filing a Notice of Appeal, a Supplemental Amendment under C.F.R. § 1.116 and a Petition of Extension of Time under 37 C.F.R. § 1.136.

Applicants turn now to the rejections at issue: Claims 3-7 and 9 have been examined and are all the claims pending in the application.

I. Claim Rejection under 35 U.S.C. § 112

Claim 9 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The Examiner states that the preamble of the claim recites both a storage medium and a system, and it not clear what the claim is directed to. In order to narrow the issues on appeal, Applicants

note that a Supplemental Amendment under C.F.R. § 1.116 has been filed with an amended claim 9. Applicants respectfully submit that the amended claim 9 is clearly directed to a storage medium storing a control program. Therefore, the Examiner is requested to withdraw the claim 9 rejection based on 35 U.S.C. § 112, second paragraph.

II. Claim Rejections - 35 U.S.C. § 103

Claims 3-7 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Furst (U.S. Patent No. 6,297,819) in view of Yates et al. (U.S. Patent No. 6,330,586). In the February 16, 2006 Amendment, Applicants amended claims 3, 6, and 9 to define the translation instructing banner as a non-programmed conversion instructing banner.

A. Claim 3, 4 and 5

In the Final Office Action, the Examiner states that the non-programmed "translation" (Applicants assume the Examiner is referring to "conversion") instructing banner is disclosed by item 116 of Figure 1, and described at col. 4, lines 40-41 of Furst. Applicants submit that neither the Figure itself or the description of item 116 suggest a *non-programmed* conversion instructing banner as claimed. Rather, item 116 is a component application tool. The component tools monitor a user while the user is browsing the web, and enables a user to obtain and interact with context-sensitive services and information based on the user's browsing activity (see Furst col. 1, lines 55-67). Further, the application tools run on the user system (client) itself. Thus, there is no suggestion of a non-programmed conversion instructing banner in Furst. Indeed, Furst teaches that the component application tools operate as a *program embedded in the client* (see col. 2, lines 29-30). In detail, Furst discloses that the discussion tool 116, as a particular example

of the component application tool, operates as a program which runs on the user computer 120 (see col. 8, line 49 - col. 10, line 54, and particularly col. 9, line 9, and col. 11, lines 65-67).

Applicants also again submit that the "banner" is not a program, but an image included in a web page (HTML file) which a user is browsing, that is, serving only as a button for a "conversion implementing request." Accordingly, the "banner" cannot run on the user system itself to monitor the user as taught by Furst. Instead of the "banner", the browser recognizes the click of the banner and accesses a linked web site.

In addition, a conversion instructing banner in the claimed invention is arranged in contents (webpage) in the contents server, whereas the Application tool page is not arranged in the web browser window (see Fig. 1). Further, the "blower extensions" recited in the Furst's reference are known for allowing developers to provide easy access to their browser enhancements by adding elements (like an Explorer Bar) to the default user interface. This feature enables developers to create Explorer Bars and add entries into the standard context menus. This feature also allows developers to add entries into the Tools menu and buttons to the toolbar. This argument was not addressed by the Examiner in the Response to Arguments section starting at page 5 of the Final Office Action.

Further, in the February 16, 2006 Amendment, Applicants noted that the Examiner maintains that Furst describes a conversion fee charging processing feature citing column 10, lines 26-28. However, this section of Furst describes only a subscription feature allowing a user to subscribe (join) to a discussion group. There is no mention in Furst of conversion fees or a charging system in the process of the user subscribing to a discussion group. The Examiner

contends that Yates teaches a charging method based on usage history and it would have been obvious to one of ordinary skill in the art to modify Furst to include a charging fee based on the usage history. Since no disclosure of any conversion fee or charging system is taught by Furst, one skilled in the art would have no motivation to modify Furst based on the teachings of Yates. Therefore, the Examiner's obviousness argument is rendered moot.

Yates does not cure the deficient teachings of Furst in regards to a non-programmed conversion instructing banner and a conversion fee charging system as discussed above. Therefore, Furst and Yates, alone or in combination, do not disclose, teach or suggest the present invention as stated in claim 3.

Since claims 4 and 5 depend upon claim 3, Applicants submit that the claims are patentable at least by virtue of their dependency.

B. Claims 6 and 7

Claims 6 recites features analogous to claim 3 which has been shown to contain patentable subject matter above. Therefore, Applicants respectfully submit claim 6 is patentable for at least reasons analogous to those given above with respect to claim 3.

Since claim 7 depends upon claim 6, Applicants submit that claim 7 is patentable at least by virtue of its dependency.

C. Claim 9

Claims 9 recites features analogous to claim 3 which has been shown to contain patentable subject matter above. Therefore, Applicants respectfully submit claim 9 is patentable for at least reasons analogous to those given above with respect to claim 3.

III. Conclusion

In view of the above, Applicants submit that the rejections are improper and that the application is in condition for allowance. Also, the USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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